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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/459,182 12/07/99 GAVELA VAZQUEZ

EXAMINER
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PM82/0609

JUAN JOSE GAVELA VAZQUEZ  
CTRA ZAMANS 190  
363190 VIGO  
SPAIN

ART UNIT	PAPER NUMBER
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GROSZ, A

AIR MAIL

DATE MAILED:

06/09/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ 9 PAGE APPENDIX -SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 3628

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

The specification, including the drawings, fail to clearly describe applicant's invention, and has numerous errors that need to be corrected. For example only the third paragraph on page 2, (lines 22-24) and the last sentence on page 4, are not understood.

If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a

Art Unit: 3628

complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

It is simply not clear what exactly is the claimed structure of claim 1.

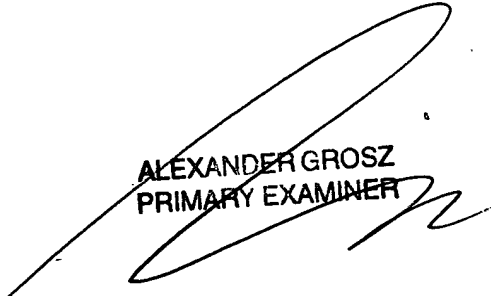
Franco et al, Shoenhair et al and Anderson are cited as relevant art.

A nine page "Appendix" useful in preparing a response, is enclosed for applicant's convenience.

Any inquiry concerning this communication should be directed to Examiner Grosz at telephone number (703) 308-2168.

Grosz/ph

June 6, 2000



ALEXANDER GROSZ  
PRIMARY EXAMINER

## APPLICANT'S RESPONSE

The remainder of this Office Action consists of general information for the Applicant's benefit. Please see the enclosed copies of Title 37 of the Code of Federal Regulations, Sections 1.111-1.121 for details concerning the examination process and the requirements for the Applicant's response. Sections 1.118-1.121 deal specifically with the subject of amendments to the specification and claims.

Unless the Office explicitly requests the return of a paper, all papers mailed to the Applicant are intended to be kept by the Applicant for his own records.

### 1. AMENDMENTS TO THE SPECIFICATION

Any amendments to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line. No new matter may be entered.

It is not necessary to submit a new specification unless one has been required by the Examiner. An example of an amendment to the specification might appear as follows:

On page 16, line 12, change "effect" to --affect--.

On page 23, line 4, insert --bucket-- after "backhoe".

### 2. AMENDMENTS TO THE CLAIMS

The enclosed copies of the Manual of Patent Examining Procedure, Sections 608.01(i) and 608.01(m) outline the proper format and content of the claims. For examples of the correct format, please see the claims in the enclosed patents.

Amendments to the claims may also be presented in the above format. If an amendment to a claim is rather extensive, however, the claim should be completely rewritten, and the additions to the claim should be underlined. Further, any deletions from a claim must be enclosed in brackets. No new matter may be entered.

For example, if a claim for a chair were originally written as follows:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted. The words --four-- and --legs attached to said seat-- have been inserted.

If the specification or drawings originally described the inclusion of four legs on the chair, the new limitation of "four legs" in the claim would not constitute new matter.

### 3. ARGUMENTS

If an Office Action contains a rejection or objection to the claims, the Applicant MUST respond with arguments under the heading "Remarks", pointing out disagreements with the Examiner's contentions. The Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or patentably distinguish from them. The applicant must respond to every ground of rejection and objection set forth in the Office Action. For more details of the amendment process, the Applicant is referred to the attached photocopies of 37 CFR Rules 1.118 through 1.121.

### NEW MATTER

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. "New matter" constitutes any material which meets the following criteria:

1. it is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

2. it contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

Please see the enclosed copy of Title 37 of the Code of Federal Regulations, Section 1.118 for details of "new matter".

#### PERIOD FOR RESPONSE

The three-month shortened statutory period specified in the cover letter (form PTO-326) is the period of time which the Applicant has to respond to every rejection and objection within this Office action. The Applicant's response must be received within three months of the date listed on the cover letter, or the application will be held abandoned.

However, this period for response may be extended up to a maximum of six months, with the payment of the appropriate fee. The following table lists the required fee for extensions of the three-month period:

Number of months after mailing date of Office Action	Fee
0-1	0
1-2	0
2-3	0
3-4	\$ 55
4-5	\$185
5-6	\$435

**These fees may not be currently correct and are provided to the applicant only to help explain how the time period may be extended.**

For example, if the response is filed four months and one day after the mailing date of the Office Action, the response must be accompanied by a fee in the amount of \$185. The response must also contain a statement requesting "an extension of the period for response under 37 CFR 1.136(a)".

#### CERTIFICATE OF MAILING

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on

(date)

(signature)

This "certificate" may appear anywhere on the page, and may be handwritten or typed. It must be signed by the person who actually deposits the paper with the Postal Service, and the date must be the actual date on which it is mailed.

For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays do not affect the extension-of-time fee.

This "certificate" may appear anywhere on the page, and may be handwritten or typed. It must be signed by the person who actually deposits it with the Post Office.

**The following excerpts are from the Manual of Patent Examining Procedure and may be helpful in the prosecution of this application.**

608.01(h) Mode of Operation of Invention [R-8]

The best mode contemplated by the inventor of carrying out his >or her< invention must be set forth in the description. >see 35 U.S.C. 112. There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification. In re Gay, 309 F.2d 768, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. In re Honn, 364 F.2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment. In re Sherwood, 204 USPQ 537 (CCPA 1980).<\*\*

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure, In re Gay, 135 USPQ 311 (CCPA 1962); In re Glass, 181 USPQ 31 (CCPA 1974). See 35 U.S.C. 112 and 37 CFR 1.71(b). Sylgab Steel & Wire Corp. v. Imoco-Gateway Corp., 357 F. Supp. 657, 178 USPQ 22 (N.D. Ill. 1973); H. K. Porter Co., Inc. v. Gates Rubber Co., 187 USPQ 692, 708, (D. Colo. 1975).\*\*

>If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. In re Hay, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.<

Patents have been held invalid in cases where the patentee did not disclose the best mode known to him. See Flick-Reedy Corp. v. Hydro-Line Manufacturing Co., 351 F.2d 546, 146 USPQ 694 (CA 7 1965), cert. denied, 383 U.S. 958, 148 USPQ 771 (1966); Indiana General Corp. v. Krystinel Corp., 297 F. Supp. 427, 161 USPQ 82 (S.D.N.Y. 1969), affirmed, 421 F.2d 1033, 164 USPQ 321 (CA 2 1970); Dale Electronics, Inc. v. R.C.L. Electronics, Inc., 488 F.2d 382, 180 USPQ 235 (CA 1 1973); Union Carbide Corp. v. Borg-Warner Corp., 550 F.2d 355, 193 USPQ 1 (CA 6 1977); Reynolds Metals Co. v. Acorn Building Components Inc., 548 F.2d 155, 163, 192 USPQ 737 (CA 6 1977).

NOTE. - Completeness, >MPEP< § 608.01(p).

#### 608.01(i) Claims [R-8]

SEE , 37 CFR 1.75 Claim(s).

- (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
- (b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.
- (c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.
- (d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a).)
- (2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.
- (e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

- (f) If there are several claims, they shall be numbered consecutively in Arabic numerals.  
(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.

#### NOTE

Numbering of Claims, >MPEP< § 608.01(j).  
Form of Claims, >MPEP< § 608.01(m).  
Dependent claims, >MPEP< § 608.01(n).  
Examination of claims, >MPEP< § 706.  
Claims in excess of fee, >MPEP< § 714.10.

#### 608.01(j) Numbering of Claims

SEE , 37 CFR 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with § 1.121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

In a single claim case, the claim is not numbered.  
Form Paragraph 6.17 may be used to notify applicant.

#### ¶ 6.17 Numbering of Claims, 37 CFR 1.126

The numbering of claims is not in accordance with 37 CFR 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR 1.121(b), they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims [1] have been renumbered [2], respectively.

#### 608.01(k) Statutory Requirement of Claims

35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he or she regards as his or her invention. The portion of the application in which he or she does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

#### 608.01(l) Original Claims

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective; not the claim.

It is of course to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.

#### 608.01(m) Form of Claims [R-8]

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim". "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. A claim may be typed with the various elements subdivided in paragraph form.

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art see >MPEP< § 706.03.

#### 608.01(n) Dependent Claims [R-8]

37 CFR 1.75(c) reads as follows for applications filed prior to January 24, 1978:

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

#### MULTIPLE DEPENDENT CLAIMS

37 CFR 1.75(c) reads as follows for applications filed on and after January 24, 1978.

SEE , 37 CFR 1.75 Claim(s).

\*\*\*\*\*

(c) one or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.



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Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

The second paragraph of 35 U.S.C. \* 112 has been revised in view of the multiple dependent claim practice introduced by the Patent Cooperation Treaty. Thus, >35 U.S.C.<\* 112 authorizes multiple dependent claims in applications filed on and after January 24, 1978, as long as they are in the alternative form (e.g., "A machine according to claims 3 or 4, further comprising —"). Cumulative claiming (e.g., "A machine according to claims 3 and 4, further comprising —") is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4 made by a process of claims 5, 6, 7, or 8" is improper. Section 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using Form Paragraph 7.45.

#### ¶ 7.45 Improper Multiple Dependent Claims

Claim [1] objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim [2]. See MPEP 608.01(n). Accordingly, [3] has not been further treated on the merits.

#### Examiner's Note:

1. In bracket 2, insert " should refer to other claims in the alternative only", and/or, "cannot depend from any other multiple dependent claim".
2. Use this paragraph rather than 35 U.S.C. 112, fifth paragraph.
3. In bracket 3, insert "the claim has" or "these claims have".

The following are excerpts from the United States Code, Title 37 and may be helpful to the prosecution of this application.

#### § 1.111 Reply by applicant or patent owner.

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear through

out to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See 1.135 and -1.136 for time for reply.)

[46 FR 29182, May 29, 1981]

#### 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objections to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981]  
AMENDMENTS

#### § 1.115 Amendment.

The applicant may amend before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with ww 1.510(e) and 1.530(b) prior to reexamination and during reexamination proceedings in accordance with 1.112 and -1.116.

[46 FR 29183, May 29, 1981]

#### § 1.116 Amendments after final action.

(a) After final rejection or action 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981]

#### § 1.117 Amendment and revision required.

The specification, claims, and drawings must be amended and revised when required to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification, and the drawing.

#### § 1.118 Amendment of disclosure.

(a) No amendment shall introduce new matter into the disclosure of an application after the filing date of the application (§ 1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with 1.63 or 1.67 filed after the filing date of the application.

(b) If it is determined that an amendment filed after the filing date of the application introduces new matter, claims containing new matter will be rejected and deletion of the new matter in the specification and drawings will be required even if the amendment is accompanied by an oath or declaration in accordance with 1.63 or § 1.67.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.119 Amendment of claims.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in § 1.121. The requirements of 1.111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

[32 FR 13583, Sept. 28, 1967]

§ 1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984]

§ 1.122 Entry and consideration of amendments.

(a) Amendments are entered by the Office by making the proposed deletions by drawing a line in red ink through the word or words cancelled and by making the proposed substitutions or insertions in red ink, small insertions being written in at the designated place and large insertions being indicated by reference.

(b) Ordinarily all amendments presented in a paper filed while the application is open to amendment are entered and considered, subsequent cancellation or correction being required of improper amendments. Untimely amendment papers may be refused entry and consideration in whole or in part. For amendments presented during an interference see § 1.664.

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

§ 1.123 Amendments to the drawing.

No change in the drawing may be made except with permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the submission of a substitute drawing by applicant. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed for approval by the examiner and should be a separate paper.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

§ 1.124 Amendment of amendments.

When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.

§ 1.125 Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with § 1.121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967]